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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,325	01/03/2002	Harry W. Eberle III	(HWE-107A)	5841
7590	12/24/2003		EXAMINER	
KENNETH P. GLYNN, ESQ. Glynn & Associates, P.C. 24 Mine Street Flemington, NJ 08822			GARCIA, ERNESTO	
			ART UNIT	PAPER NUMBER
			3679	

DATE MAILED: 12/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/037,325	EBERLE, HARRY W.	
	Examiner Ernesto Garcia	Art Unit 3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 21-28 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 21-28 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 12 September 2003 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 - a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Drawings

The drawings were received on 9/12/03. These drawings are acceptable.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 21, 24 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Zibell, 3,319,983 (see marked-up attachment).

Regarding claim 21, Zibell discloses in Figure an anchoring device comprises a substantially flat horizontal top element **A1**, at least one substantially vertical support member **A5**, and a substantially flat horizontal bottom element **A9**. The top element **A1** has a top view configuration including two sides **A2** and a predetermined first width **W₁** as measured side to side. The first width **W₁** is measured at a maximum width between the sides **A2**. The top element **A1** has an imaginary center line **A4**. The support member **A5** is attached to an underside **A6** of the top element **A1** along the center line

A4 and the support member **A5** extends downwardly therefrom. The support member **A5** has two sides **A7** and a predetermined second width **W₂** as measured side to side at a maximum width. The bottom element **A9** has a flat bottom view configuration which includes sides **A10** and having a generally trapezoidal shape, and a predetermined third width **W₃** as measured side to side at a maximum width at a trapezoidal base **B1**. The first width **W₁** is greater than the second width **W₂** and the third width **W₃**. The third width **W₃** is greater than the second width **W₂**.

Applicant is reminded that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Therefore, the anchoring device can be adapted to maintain the top element in a predetermined position during use for joinder of two adjacent boards pre-cut with receiving slots, and to position the bottom element upon a support board, which the two boards rest for attachment of the anchoring device to the support board for anchoring and support the two boards.

Regarding claim 24, Zibell discloses in Figure 5, a decking system comprises decking boards **A** and an anchoring device **70**. Each of the decking boards **A** has a top **A21**, a bottom **A22**, two sides **A23** and two ends **A24**. At least one groove **34** is located along one of the sides **A23**. The an anchoring device **70** comprises a substantially flat horizontal top element **A1**, at least one substantially vertical support member **A5**, and a

substantially flat horizontal bottom element **A9**. The top element **A1** has a top view configuration including two sides **A2** and a predetermined first width **W₁** as measured side to side. The first width **W₁** is measured at a maximum width between the sides **A2**. The top element **A1** has an imaginary center line **A4**. The support member **A5** is attached to an underside **A6** of the top element **A1** along the center line **A4** and the support member **A5** extends downwardly therefrom. The support member **A5** has two sides **A7** and a predetermined second width **W₂** as measured side to side at a maximum width. The bottom element **A9** has a flat bottom view configuration which includes sides **A10** and having a generally trapezoidal shape, and a predetermined third width **W₃** as measured side to side at a maximum width at a trapezoidal base **B1**. The first width **W₁** is greater than the second width **W₂** and the third width **W₃**. The third width **W₃** is greater than the second width **W₂**.

Applicant is reminded that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Therefore, the anchoring device can be adapted to maintain the top element in a predetermined position during use for joinder of two adjacent boards pre-cut with receiving slots, and to position the bottom element upon a support board, which the two boards rest for attachment of the anchoring device to the support board for anchoring and support the two boards.

Regarding claim 27, the groove **34** establishes an upper half of each of the decking boards **A** above the groove **34** and a lower half of each of the decking boards **A** below the groove **34**. The upper half has a greater width than the lower half.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22, 23, 25, 26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zibell, 3,349,983.

Regarding claims 22 and 25, Zibell, as discussed above, fails to disclose the support member **A5** having recesses with support columns located therebetween. It would have been obvious matter of design choice to modify the anchoring device of Zibell by having recesses with support columns located therebetween. Since applicant has not disclosed that the recesses with the support columns solves any stated problem or is for any particular purpose, one of ordinary skill would remove material of the device to make the device weight less as by including recesses such as holes or slots through

the support member, the top element, or the bottom element. Applicant is reminded that the support columns are inherently made as a result of the recesses being present.

Regarding claims 23 and 26, Zibell, as discussed above, fails to disclose the device made of molded plastic material. Applicant is reminded that, within the general skill of a worker in the art, selecting a known material on the basis of its suitability for the intended use is a matter of obvious design choice. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the device of plastic. *In re Leshin*, 125 USPQ 416. Furthermore, it is well known that plastic material is capable of having a metal fastener driven through.

Regarding claim 28, Zibell, as discussed above, fails to disclose the decking boards **A** made of material selected from a group consisting of synthetic polymers, at least partially foamed synthetic polymer, wood, wood composite, and combinations thereof. Applicant is reminded that, within the general skill of a worker in the art, selecting a known material on the basis of its suitability for the intended use is a matter of obvious design choice. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the decking boards **A** out of any known material. *In re Leshin*, 125 USPQ 416.

Response to Arguments

Applicant's arguments filed 9/12/03 have been fully considered but they are not persuasive.

Applicant has argued that Zibell is no longer appropriate to be cited against claim 2, now new claim 21, since the marked up reference A9 is not a trapezoid, nor does it have a trapezoidal shape. This is not found persuasive since the language "generally trapezoidal" allows for variation of a trapezoid. Furthermore, Zibell shows a trapezoidal with truncated edges. The examiner has shown the truncated edges in the attached figure using dashed lines to make the argument clear.

Applicant has further argued that the Zibell's component does not have a flat bottom as Zibell's bottom is tapered upwardly from the center of the bottom. This is not found persuasive since reference B1, as shown in the attachment, shows the bottom being flat.

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Johansen show a similar anchoring device having a flat horizontal element having a generally trapezoidal shape (Fig. 1).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 703-308-8606. The examiner can normally be reached from 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne H Browne can be reached on 703-308-1159. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications. Any inquiry of a general nature or relating to the status of this

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application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.


Lynne H. Browne
Supervisory Patent Examiner
Technology Center 3600

E.G.

December 12, 2003

Attachment: one marked-up copy of Zibell, 3,319,983.

3,319,983

